

REMARKS

Claims 23-38 are pending in the above-captioned patent application. Claims 29-36 have been allowed. Claims 23-28, 37 and 38 have been rejected. Claims 23, 25 and 38 have been amended to overcome the formal grounds of rejection and/or to further clarify what Applicant regards as the present invention.

Specifically, Claim 23 has been amended to clarify that the thumb switch performs multiple functions. Support for this amendment is found in Figures 2B and 3A-3C of the drawings and in the specification at page 3, lines 18-35.

Claim 25 has been clarified to provide that the thumb switch plate selectively contacts each of the electrical contacts upon sufficient movement of the thumb switch plate relative to the thumb base plate. Support for this amendment can be found in Figures 3A-3C. Claim 38 has been amended in a somewhat similar fashion. Further, Claim 38 has been amended to provide that the annular switch includes four individual quadrant switches. Support for this amendment can be found in Claim 24.

Reconsideration of the rejected claims is respectfully requested in view of the above-recited amendments and the arguments set forth below.

Interview Summary

On April 5, 1999, the undersigned attorney for the Applicant conducted a telephonic interview with the Examiner, John Tweel. Prior to the telephonic interview, a draft response was forwarded to the Examiner. Based upon the draft response, the Examiner preliminarily indicated that claim 23 overcomes the 35 USC § 102 rejection. Claim 24 was also discussed. No decision was reached on the patentability of claim 24.

Rejections Under 35 U.S.C. § 102(b)

Claim 23 is rejected under 35 U.S.C. § 102(b) as being anticipated by Paley (U.S. 2,396,871). The Patent Office provides that Paley includes the claimed multiple function thumb switch positioned on the top side of the body is met by the thumb push button (No. 18). Applicant respectfully submits that Claim 23, as amended, overcomes Paley.

Paley relates to a remote control which includes three, single function on/off type switches. One of the switches is designed to be engaged by the thumb, one by the index finger and one by the remaining fingers. The mouse includes means, mounted in the housing, for locating the mouse with respect to at least one spatial dimension and orientational dimension. (Column 2, Lines 7-18)

In distinction to Paley, amended Claim 23 recites that the thumb switch is adapted to perform multiple functions. Because Paley lacks teaching of a thumb switch which performs multiple functions, as is required to substantiate a § 102(b) rejection, the rejection is overcome with respect to Claim 23 and Paley. Because Claims 24-28, 37 and 38 depend directly or indirectly on Claim 23, they are likewise patentably distinguishable over Paley.

Rejections Under 35 U.S.C. § 103

Claims 24, 25, 27, 37, and 38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Paley in view of Miyakawa (U.S. 4,931,781). The Patent Office provides that Paley does not mention an annular switch including four individual quadrant switches. The Patent Office cites Miyakawa for teaching, an annular switching device (No. 306) which

slides between four quadrant contacts (Nos. 308 and 310). The Patent Office provides that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate an annular switch using four quadrant switches similar to that of Miyakawa for the purpose of increasing the operability and the versatility of the switching apparatus. Applicant respectfully traverses this rejection.

Miyakawa discloses a switch which uses a circular key top 306 which slides and makes contacts with a plurality of spherical balls 309 and plate spring contacts 310. In contrast, Claim 24 requires a center switch and an annular switch which surrounds the center switch. (Emphasis added) This feature allows the user to depress the annular switch and/or the center switch without removing the thumb from the switches. Claim 37 includes somewhat similar limitations. Even if Paley can be combined with Miyakawa, the circular switch of Miyakawa would not allow for it to encircle the switch of Paley. Instead, assuming that Paley can be combined with Miyakawa, the resulting switches would have to be adjacent each other. Thus, the user would have to remove the finger from one switch to maneuver the other switch. Accordingly, Claims 24 and 37 are considered to be patentable.

Further, there is no teaching or suggestion to combine Miyakawa with Paley. In order to combine the references, there must be some teaching within the references themselves which teaches or suggest the combination. Ashland Oil, Inc. v. Delta Resins & Refracs, Inc. 776 F.2d 281 (Fed. Cir. 1985). It is irrelevant that the individual elements of Applicant's invention may be found elsewhere in the prior art, extremely modified, and reconstructed to achieve Applicant's invention without any suggestion from the prior art to make the combination. See, e.g., Akzo N.U. v. United States ITC, 808 F.2d 1471 (Fed. Cir.

1986). After all, only God works from nothing while man must work from old elements. Fromson v. Advance Offset Plate, Inc. 755 F.2d 1556 (note 3 Fed. Cir. 1985); Amstar Corp. v. Envirotech Corp., 730 F.2d 1476, 1476, 1483 (Fed. Cir. 1984).

Applicant submits that there is no teaching or suggestion to combine Miyakawa with Paley. With Paley, the mouse includes means for locating the mouse with respect to at least one spatial dimension and orientational dimension. Thus, there is no teaching or need to add an additional multiple function switch to the mouse of Paley.

Because Claims 25 and 38 depend from and containing all limitations of Claim 24 or 37, they are also considered to be patentable.

Claim 25

Claim 25 requires that at least one of the quadrant switches includes a plurality of spaced apart electrical contacts and a thumb switch plate which is adapted to move relative to thumb base plate, wherein the thumb switch plate selectively contacts each of the electrical contacts upon sufficient movement of the thumb switch plate relative to the thumb base plate. (Emphasis added) Claim 38 includes somewhat similar limitations.

Neither of the cited references teach or suggest this feature. In particular, Miyakawa teaches the use of a single, cantilevered electrical contact for each switch. Paley teaches the use of a simple, single contact switch. In summary, neither reference teaches a thumb switch plate which selectively contacts each of the electrical contacts. Further, as provided above, there is no teaching to combine Paley with Miyakawa. Accordingly, Claim 25 and 38 are considered patentable.

Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Paley in view of Ebina et al. (U.S. 4, 812,829). As provided above, Claim 23 is considered to be

patentable. Because Claim 26 depends from and contains all of the limitations of Claim 23, it is also considered to be patentable.

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Paley in view of Evans et al. (U.S. 5,412,377). As provided above, Claim 23 is considered to be patentable. Because Claim 28 depends from and contains all of the limitations of Claim 23, it is also considered to be patentable.

Remaining References

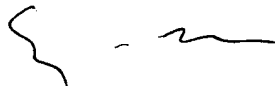
The references cited by the Examiner, but not relied on for the rejection of claims, have been noted. The remaining references are no more pertinent than the applied references, therefore, a detailed discussion of these remaining references is deemed unnecessary for a full and complete response to the Office Action.

Conclusion

In conclusion, Applicant respectfully asserts that Claims 23-38 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 619-455-5700 for any reason that would advance the instant application to issue.

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Respectfully submitted,



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